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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,998	06/06/2001	Laurence Bellagamba	35-0016	8117

7590

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EXAMINER

KHATRI, ANIL

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 05/20/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,998

Applicant(s)

BELLAGAMBA, LAURENCE

Examiner

Anil Khatri

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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The abstract of the disclosure is objected to because it does not appear to depict the cursory inspection the nature and gist of the technical disclosure and shall not be used for interpreting the scope of the claim. Further, the numbers listed in the abstract should be avoided. Correction is required. See MPEP § 608.01(b).

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and

problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the

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World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because they disclose a claimed invention that is an “abstract idea” as defined in the case *In re Warmerdam*, 33 F.3d 1354, 31, USPQ2d 1754 (Fed. Cir. 1994).

Examiner interprets that the claims are non-statutory because they are not new and useful. Applicant presents no substance upon which the claimed invention acts and on the basis the examiner believes invention represents a purely an abstract idea and non-structural and functionality can be realized. Further, claims 4, 12 and 20 are system claims and applicant claiming, “a tool provider includes a development team”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by *Fromme* USPN 5,075,847.

Regarding claim 1

Fromme teaches,

- a customer relaying customer tool requirements for a tool to a tool provider (see abstract);
- a tool provider generating a custom tool based on the tool requirements received from the customer and storing the custom tool on a remote server accessible by the customer (figures 3 and 4, column 3, lines 23-33, “action by application tool... remote host computer”); and
- a remote server accessible by the customer wherein said remote server includes (figures 3 and 4, column 3, lines 23-33, “action by application tool... remote host computer”);
- a database storing the custom tool (column 5, lines 21-23, “a work area... tool execution”);
- a database for storage by users of the customer (column 5, lines 57-61, “the work station an each access... shown in fig 2”); and
- a project database (column 9, lines 25-41”).

Regarding claim 2

Fromme teaches,

- Tool provider includes a system administrator for interpreting the tool requirements received from the customer and generating custom application specific tool requirements (figure 6, column 1, lines 35-39, column 8, lines 17-32, “integrating application tolls... system signal 47”).

Regarding claim 3

Fromme teaches,

- tool provider includes a number of system engineering software modules (column 6, lines 20-23, “the CASE system... user intervention”).

Regarding claim 4

Fromme teaches,

- tool provider includes a development team receiving custom application specific tool requirements and system engineering software modules and generating a custom tool (column 2, lines 55-67, “software development system... requesting action by the application..”, column 4, lines 52-57, “the tool integration... custom application tool”).

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Regarding claim 5

Fromme teaches,

- database for storage of project elements awaiting approval (column 6, lines 45-51, “when any tool in the CASE modifies... out of date”).

Regarding claim 6

Fromme teaches,

- including an approver at the customer for reviewing project elements stored in said approval database (column 6, lines 54-66, “the edit tool 10 sends... update its database with new source file”).

Regarding claim 7

Fromme teaches,

- customer determines new features and transmits new features to tool provider (column 6, lines 35-43, “the message server 36 ... class of tools”).

Regarding claim 8

Fromme teaches,

- tool provider modifies custom tool based on new features (column 6, lines 54-66, “the edit tool 10 sends... update its database with new source file”).

Regarding claim 9

Fromme teaches

Rejection of claim 1 is incorporated and further claim 9 recites limitations as cited in claim 1, therefore claim 9 is rejected under same rational as claim 1.

Regarding claim 10

Fromme teaches

Rejection of claim 9 is incorporated and further claim 10 recites limitations as cited in claim 2, therefore claim 10 is rejected under same rational as claim 2.

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Regarding claim 11

Fromme teaches

Rejection of claim 9 is incorporated and further claim 11 recites limitations as cited in claim 3, therefore claim 11 is rejected under same rational as claim 3.

Regarding claim 12

Fromme teaches

Rejection of claim 9 is incorporated and further claim 12 recites limitations as cited in claim 4, therefore claim 12 is rejected under same rational as claim 4.

Regarding claim 13

Fromme teaches

Rejection of claim 9 is incorporated and further claim 13 recites limitations as cited in claim 5, therefore claim 13 is rejected under same rational as claim 5.

Regarding claim 14

Fromme teaches

Rejection of claim 9 is incorporated and further claim 14 recites limitations as cited in claim 6, therefore claim 14 is rejected under same rational as claim 6.

Regarding claim 15

Fromme teaches

Rejection of claim 9 is incorporated and further claim 15 recites limitations as cited in claim 7, therefore claim 15 is rejected under same rational as claim 7.

Regarding claim 16

Fromme teaches

Rejection of claim 9 is incorporated and further claim 16 recites limitations as cited in claim 8, therefore claim 16 is rejected under same rational as claim 9.

Regarding claim 17

Fromme teaches

Rejection of claim 1 is incorporated and further claim 17 recites limitations as cited in claim 1, therefore claim 17 is rejected under same rational as claim 1.

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Regarding claim 18

Fromme teaches

Rejection of claim 17 is incorporated and further claim 18 recites limitations as cited in claim 2, therefore claim 18 is rejected under same rational as claim 2.

Regarding claim 19

Fromme teaches

Rejection of claim 17 is incorporated and further claim 19 recites limitations as cited in claim 3, therefore claim 19 is rejected under same rational as claim 3.

Regarding claim 20

Fromme teaches

Rejection of claim 17 is incorporated and further claim 20 recites limitations as cited in claim 4, therefore claim 20 is rejected under same rational as claim 4.

Regarding claim 21

Fromme teaches

- project elements awaiting approval are reviewed (figure 6).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- USPN 5933828
- USPN 6256774
- USPN 5485569
- USPN 5802514
- USPN 6134318

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anil Khatri, Primary Examiner whose telephone number is 703-305-0282. The examiner can normally be reached on M-F 8:30-5:00 PM.

. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANIL KHATRI
PRIMARY EXAMINER